

Remarks

In view of the following remarks, favorable reconsideration of the outstanding office action is respectfully requested. Claims 1 – 24 remain in this application. Claim 12 has been amended.

1. Allowed Claims/Subject Matter

Applicants note with appreciation the Examiner's allowance of claims 5 – 18. Applicants also note with appreciation that the Examiner has indicated that the subject matter of claims 3, 4, and 24 is patentable, and would be allowable if rewritten in independent form.

2. § 112 Rejections

The Examiner has rejected claims 16 – 19 under 35 U.S.C. § 112, second paragraph, as being indefinite for insufficient antecedent basis. In particular, the Examiner asserts that the phrase "said second network" lacks antecedent basis in the claim. In response, the Applicants have amended claim 12 to provide the antecedent basis for the term second network.

3. § 103 Rejections

The Examiner has rejected claims 1 – 2 and 20 – 23 under 35 U.S.C. § 103 as being unpatentable for obviousness over U.S. Patent No. 5,835,710 to Nagami et al. [hereinafter Nagami] in view of U.S. Patent No. 6,507,577 to Mauger et al. [hereinafter Mauger].

Nagami is directed to a packet transfer scheme in an ATM network system in an internet environment. A network interconnection apparatus (router) has a memory for storing mapping data which correlates the IP address of a packet received from one logical network and the IP address of a packet being transmitted to another logical network. The mapping information allows the router to translate the IP addressing into the proper data link layer addressing.

Mauger is directed to a system that provides voice and media services over an IP network incorporating a plurality of nodes and in which connection oriented traffic is

transported in tunnels via the nodes. The purpose of a tunnel is to facilitate routing of packets. A packet within a tunnel can pass through a node without that node needing to have any knowledge of the destination of that packet, nor even of the next node at which the packet will arrive, as the packet can remain within the tunnel until emerging at its final destination. SS7 signaling is used between voice over IP nodes because SS7 signaling provides access to Intelligent Network applications provided by the Public Switched Telephone Network (PSTN).

According to the **MPEP 2143**, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A. The prior art references do not teach or suggest all the claim limitations.

Claim 1:

The Examiner asserts that Nagami discloses a system and method for providing multimedia conferencing services (voice, data and/or video) over an ATM network interconnecting IP customer premises (Fig. 1). The Examiner admits that Nagami does not teach establishing an ATM virtual circuit by use of proxy addressing. However, the Examiner asserts that Mauger teaches a proxy server (block 65 in Figure 6). The Examiner states that the proxy server "can be implemented into the router of Nagami for securing and communicating between protocols." First, the Applicants point out that it is not likely that one of ordinary skill in the art would ever be motivated to incorporate any type of server into a router. These devices are used for entirely different functions within a network. Routers include mapping data that direct packets to other routers. A proxy server is used to establish sessions between end users. Second and more importantly, the Examiner fails to point out the relevance of the proxy server disclosed by Mauger. Even if Mauger includes a proxy server,

that fact by itself does not make a prima facie case, because the Examiner does not point out where either Nagami or Mauger, whether taken alone or in combination, teach or suggest the step of establishing an ATM virtual circuit for said session between said first device and said second device, whereby a data path for the telephony session is secured by the use of proxy addressing, as recited in claim 1.

For the above stated reasons, neither Nagami nor Mauger, whether taken alone or in combination, teach or suggest all the claim limitations recited in claim 1.

Claim 20:

The Applicants note that the Examiner fails to provide a separate analysis for independent claim 20. The Examiner fails to point out where any of the claim elements recited in claim 20 can be found in either Nagami or Mauger.

The Examiner fails to point out where either Nagami or Mauger teach or suggest a first (or second) device connected between said IP telephony network and said ATM network, said first device providing bi-directional translation between IP media traffic and ATM traffic, as recited by claim 20. Router 601 (Nagami) cannot be the first device because it only provides a data link layer/IP address translation in a single ATM network that interconnects a plurality of ATM LANs. The router does not connect an IP telephony network and an ATM network and does not *translate* IP media traffic and ATM traffic.

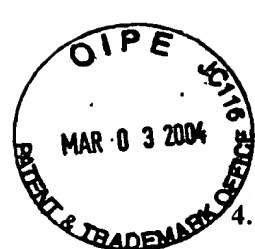
The Examiner fails to point out where either Nagami or Mauger teach or suggest an intelligent control layer for establishing a virtual circuit through said ATM network for an IP telephony session between the calling party and the called party, whereby the first device and the second device are assigned on a per session basis, as recited in claim 20. The Examiner simply ignores this claim element.

For the above stated reasons, neither Nagami nor Mauger, whether taken alone or in combination, teach or suggest all the claim limitations recited in claim 20.

B. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

In providing reasons for combining the references, the Examiner states that “it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the proxy server for security purposes in the communications system.” Applicants point out that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In this case, the Examiner does not point out where either reference discusses implementing a “proxy server for security purposes.” Further, the Examiner fails to point to any body of knowledge generally available to one of ordinary skill in the art for this proposition.

According to MPEP 2143.01, if a proposed modification or combination of the prior art would change the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 123 USPQ 349 (CCPA 1959). In this case, Nagami is directed to an ATM network that includes ATM-LANs interconnected by routers. As the Examiner points out, each router in Nagami’s network (Figure 44, col. 42, lines 13 – 32) determines the *destination address of an incoming packet* (See also Figure 47). Mauger, on the other hand, is directed to an IP network that incorporates tunneling. As noted above, a packet within a tunnel can pass through a node *without that node needing to have any knowledge of the destination of that packet*, nor even of the next node at which the packet will arrive, as the packet can remain within the tunnel until emerging at its final destination. Therefore, one of ordinary skill in the art would not be motivated to combine Mauger with Nagami because the combination would change the principle of operation of the routers used in Nagami’s network to accommodate the tunneling employed in Mauger’s system.



4. Conclusion

Based upon the amendments, remarks, and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1 – 24 and a prompt Notice of Allowance thereon.

Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of WorldCom, Deposit Account 13-2491.

Please direct any questions or comments to Daniel P. Malley at (607) 256-7307.

Respectfully submitted,

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